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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,432

Applicant(s)

ARNOLD ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04262005.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims Status

Claims 1-16 and 18 are pending. Claims 17 and 19-25 are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "A method for converting a first file in a binary Raster Document Object (RDO) format to a second file in a second format." The specification does not include a clear and concise written description of the process of converting a first file in a RDO format to a second file in a second format.

Claim 9 includes language similar to claim 1 and is rejected for the same reasons.

Claims 2-8 and 10-16 and 18 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 in the preamble includes the following language "A method for converting a first file in a binary Raster Document Object (RDO) format to a second file in a second format." The scope of the invention cannot be determined because the second format is not ascertainable from the preamble of claim 1 nor from the body of claim 1 nor from the specification of the present application. In fact paragraph 210 of the specification states that "For example, while the presently preferred embodiment of the invention concerns the conversion of a document in the RDO format to the PDF format, it will be appreciated by those skilled in the art that, based upon the disclosure herein, documents in the RDO format may be readily converted to other formats as desired, using only those techniques known to those skilled in the art." The scope of the invention cannot be determined because it is not possible to determine what second file formats are presently desired nor what second formats are presently known to the skilled technician nor what second file formats will be possible in the future due to future techniques available to the skilled technician.

Claim 9 includes language similar to claim 1 and is rejected for the same reasons.

Claims 2-8 and 10-16 and 18 are rejected for being dependent from a rejected base claim.

Art Rejection Precluded:

Applicant states on page 2 of the response dated February 10, 2005 that this application describes and claims methods an apparatus for converting a first file in a binary Raster

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Document Object ("RDO") format, a proprietary file format by Xerox Corporation, to a second file in a second format and that references provided by the examiner have nothing whatsoever to do with the proprietary Xerox RDO format. Examiner is persuaded that any possible reference available to the examiner will not read on the claimed proprietary file format by Xerox Corporation. In this regard, the first inventor, i.e., Arnold of the present invention discloses in paragraph 76 of the specification that there is no known published documentation of the RDO format. Based on the above disclosures, an art rejection is meaningless.

Response to Arguments

Applicant's arguments filed 2/10/2005 have been fully considered but they are not persuasive.

Applicant Argues:

Applicant states on page 2 "This application describes and claims methods and apparatus for converting a first file in a binary Raster Document Object ("RDO") format, a proprietary file format by Xerox Corporation, to a second file in a second format. Despite this specificity, the Examiner has repeatedly rejected the claims of this invention based on references that have nothing whatsoever to do with the proprietary Xerox RDO format.

Examiner Responds:

Examiner reminds applicant of the statutory requirements governing the issue of a United States patent. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims which do not comply with the above are rejected for failing to comply with the enablement requirement. Examiner maintains that applicant is not complying with the enablement requirement by claiming the conversion of a first file in a binary Raster Document Object (“RDO”) format which is a proprietary file format owned by the Xerox Corporation. One of ordinary skill in the art would not be able to make and use the present invention because the best references available to the examiner “have nothing whatsoever to do with the proprietary Xerox RDO format.” Because nothing is presently known about the Xerox proprietary binary Raster Document Object (RDO) format, one of ordinary skill in the art would not be able to convert a first file in a binary Raster Document Object (RDO) format to a second file in a second format based on the very high level discussion provided in the specification. The specification does not enable one of ordinary skill in the art to analyze the binary RDO file structure, extract all relevant data needed to reproduce the content, and generate an output in the PDF format as demonstrated by the following analysis of applicant’s specification.

Paragraph 17 of the specification states:

The presently preferred embodiment of the invention provides a process and apparatus for analyzing the binary RDO file structure, extracting all relevant data needed to reproduce the content, and generation of output in the PDF format.

One of ordinary skill in the art could not begin to make and use the present invention because it is not possible to *reproduce* the content of the binary RDO file such that the binary RDO file structure can be analyzed. The only possible way that one of ordinary skill in the art can analyze the binary RDO file structure is for the binary RDO file to be made available to the skilled artisan.

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Paragraphs 18 through 23 of the specification state the following:

[0018] The conversion process to PDF takes the steps illustrated in FIG. 1.

[0019] In the first step, the binary RDO file 10 is read and analyzed 12. Its internal structure is decoded--parsed--and transferred into a data structure representation in memory.

[0020] In the second step, the data contained within the RDO file describing the arrangement of pages in the final document is extracted 14. This step is separate due to the internal organization of the RDO file. The various pieces of data pertaining to different pages are scattered throughout the file and must be collected for each page in this step. In addition, there are some page-invariant data that apply to the entire document, such as header and footer messages, their location, or font selection.

[0021] Once all of these data are gathered, the output can be generated by placing the TIFF bitmap files 18 for each page onto the output page 16 and adding the optional text messages for header, footer and page number. When all pages have been processed in this way, the final PDF file 20 is self-contained and stored on disk.

[0022] When the data files are not TIFF but PostScript, the situation is slightly different. Because positioning instructions may be included with the PostScript file, the RDO file contains only the filename. In the conversion process, an external, commercially available Postscript-to-PDF converter 22 must be invoked to merge 17 these pages'24 into the output PDF.

[0023] These three steps can be likened to the process of natural language translation of a written document. A human translator must first read 11 the document in the source language, then understand 13 it, and finally reproduce 15 it in the target language.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to read the RDO file as required in the first step of applicant's invention. The skilled artisan would be precluded from performing the first step of making and using the present invention.

The second step in the conversion process of the binary RDO file requires (refer above paragraph 20) that the various pieces of data pertaining to different pages which are scattered throughout the file must be collected. However, in the present situation, the RDO file is

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proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to collect various pieces of data pertaining to different pages which are scattered throughout the file. Obviously, the skilled artisan would be precluded from performing the second step of making and using the present invention.

The following step in the conversion process of the binary RDO file requires placing TIFF bitmap files which are bundled with the RDO file onto the output page, further processing the output page and generating the final PDF file which is stored on the disk. However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to access the TIFF bitmap files which are bundled with the RDO file. The skilled artisan would be precluded from performing the above steps in the process of making and using the present invention.

Paragraph 23 of the specification states:

These three steps can be likened to the process of natural language translation of a written document. A human translator must first read 11 the document in the source language, then understand 13 it, and finally reproduce it in the target language.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to read the document in the source language. Therefore, the skilled artisan would not be able to understand the RDO file nor be able to translate the RDO file into the target PDF file format. The skilled artisan would be

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precluded from performing the above steps in the process of making and using the present invention.

Paragraphs 38 and 39 of the specification state:

[0038] At the beginning of the RDO file (see FIG. 3) there is a 9-byte header which is not interpreted. After the header, the remainder of the file follows a common structure--that of a tree. A tree is a branched data structure that consists of intermediate directory nodes 26 and terminal leaf nodes 28. The structure is similar to that of a file system. A root folder contains several folders, i.e. directories, which, in turn, may contain more directories and/or individual files, i.e. leaves. At each directory, the tree forks into one or more branches, which ultimately terminate in leaves.

[0039] In the case of RDO, the distinction of directories vs. leaves is accomplished by prefixing each with an identifying code 25. A break-down of all codes is provided below in Table 1. This code is one byte long.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to ascertain the common tree structure, root folders, directories, individual files, leaves or the distinction between directories vs. leaves by means of the identifying code. The skilled artisan would not be able to perform the above steps in the process of making and using the present invention.

Paragraph 43 of the specification states:

Now that the basic organization of the RDO file has been explained, an algorithm is described for parsing this tree structure into memory. The algorithm for doing so is depicted schematically in FIG. 4. With this algorithm, the RDO file is read into a tree data structure in computer memory. The actual data layout is chosen by the implementer, but is similar to that shown in FIG. 3.

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However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to read the RDO file into a tree data structure in computer memory. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Paragraph 49 of the specification states:

[0049] Once the RDO tree structure has been read into memory, it is necessary to extract the relevant document and page description data that is needed to generate the PDF output. The manner in which the various data items are laid out and contained within the RDO tree structure is described below.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to extract the relevant document and page description data from the RDO tree structure which must be available in the memory of a computer. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Paragraph 51 of the specification states:

[0051] One option is to create a template similar to the expected subtree and then attempt to match this template against all trees in the RDO file in a recursive fashion. The matching algorithm returns pointers to the sought leaves of the matching RDO tree. Once the template has been matched, the desired values can be read back from the pointers. Occasionally data may be encoded in the code of the directory, e.g. for the format of the page numbers (Arabic vs. Roman). In that case, the template must read back a pointer to the appropriate directory code as well.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the

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art would not have access to the RDO file and thus will not be able to match a template against all trees in the RDO file in a recursive fashion. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Paragraph 70 of the specification includes:

If some pages are included in RDO not as TIFF but as PostScript, these have to be converted explicitly to PDF and then merged into the PDF output stream., e.g. using Acrobat Distiller by Adobe systems, Inc.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to know whether some pages in the RDO are included as TIFF or PostScript. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Paragraph 71 of the specification includes:

The codes at the beginning of each tree element determine whether the element is a directory or a leaf.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to know whether the element is a directory or a leaf. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

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Paragraph 73 of the specification includes:

As explained above, the RDO file consists of a series of trees. Once the tree structure is parsed, the data in the individual leaves must be read.

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to read the data in the individual leaves. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Paragraph 76 of the specification states:

[0076] There is no known published documentation of the RDO format. Thus, the names of the individual data groups were assigned by the inventor. These data items are all contained in various sections of the trees of the RDO file, as detailed in the parsed output below. The examples below are taken from different files to highlight certain special features. For clarity, not all trees are shown and sometimes sections within a tree may be omitted which is indicated with "[...]".

However, in the present situation, the RDO file is proprietary, i.e., privately owned and operated. Therefore, because the RDO file is not publicly available one of ordinary skill in the art would not have access to the RDO file and thus will not be able to access *all* sections of the trees of the RDO file. The skilled artisan would not be able to perform the above step in the process of making and using the present invention.

Applicant Argues:

Applicant states on page 2 "This application describes and claims methods an apparatus for converting a first file in a binary Raster Document Object ("RDO") format, a proprietary file

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format by Xerox Corporation, to a second file in a second format. Despite this specificity, the examiner has repeatedly rejected the claims of this invention based on references that have nothing whatsoever to do with the proprietary Xerox RDO format.

Examiner Responds:

Examiner is persuaded. Examiner in this Office Action has withdrawn the prior art rejection(s).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. 0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux



04/26/2005

MOHAMMAD ALI
PRIMARY EXAMINER

MOHAMMAD ALI
PRIMARY EXAMINER